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CASE PH/5-31140A

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July 13, 2004
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
GLOCK ET AL.

Art Unit: 1616
Examiner: QAZI, SABIHA NAIM

APPLICATION NO: 10/070,936

FILED: AUGUST 9, 2002

FOR: HERBICIDAL COMPOSITION

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Commissioner for Patents
P.O. Box 1450
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REQUEST FOR RECONSIDERATION

Sir:

This paper is in response to the Office Action mailed April 20, 2004, rejecting claims 1-7 of the above-referenced application. Reconsideration and withdrawal of this rejection is requested for the following reasons:

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner state that it is unclear what is the meaning of "formulation assistants" in claim 1.

The term "formulation assistants is defined in the specification at page 33, last full paragraph, lines 3-4, where the formulation assistants are defined as typically solvents or solid carriers. Withdrawal of the rejection is respectfully requested.

In addition, the Examiner has asked what the proviso at the end of claim 1 disclaims.

The proviso in claim 1 excludes those compounds of the formula I which gave unsatisfactory results in the tests carried out with the inventive compositions. No prior art is disclaimed by this proviso.

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,410,480 (Muhlebach et. al.) and WO 98/13361 (Tobler et al.).

Clarification of this rejection is respectfully requested. The Examiner states at the top of page 2 of this Office Action, item 2, that Applicants' arguments have been fully considered and were persuasive therefore rejection is withdrawn. However, it is not clear which rejection was withdrawn. Applicants' arguments were directed to the rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over EP 508 126 (US Patent 6,410,480) and WO 96/21652.

Furthermore, with reference to the Muhlebach et al. citation, Muhlebach et. al (WO 99/47525, US 6,410,480) is **NOT** prior art under 103(a)/102(e), (f), or (g). The WO 99/47525 application was filed March 3, 1999; and is not available as prior art under the revisions of the American Inventors Protection Act of 1999. International filing dates prior to November 29, 2000 cannot be used under 102(e) for prior art purposes. In fact, publications of international applications filed before November 29, 2000 do not have a 102(e) date at all.

Under pre-AIPA law which applies in this case, WO 99/47525 has a publication date of September 23, 1999, which is after the filing date of the present application. The present application has an effective filing date of September 7, 1999 (i.e. before the publication of the cited reference).

Withdrawal of Muhlebach et al. as a cited reference is respectfully requested.

The Examiner states "both the references cited above teach combinations of pyrazilinnone compositions of formula I as safeners as presently claimed which embraces Applicants' claimed invention."

Contrary to the Examiner's assertion, compounds of the present invention encompassed by formula I are herbicides and are not taught or reasonably suggested by either of the cited references. Specifically, the compounds encompassed by formula I of the present invention are characterized by (1) the bivalent chain formed by the substituents R₄ and R₅ and (2) the methyl group in the para-position of the phenyl ring. The compounds represented by formula I of the present invention represent a selection from the broader teachings of WO 99/47525, previously cited by the Examiner against the instant application and withdrawn in the outstanding office action. WO 99/47525 corresponds to US 6,410,480.

A primary difference in the compounds of the present invention (as well as the '480 patent) and EP 508 126 (as well as WO 96/21652), is that in the compounds of the present invention, R₄ and R₅ together are a group containing -O-. This is also discussed on page 14 of the present application with respect to the WO 96/21652 reference. In the '480 patent (beginning at column 76, line 51), there is provided a comparison of Compound 1.01, which falls within the scope of formula I

of the present application, and the compound closest to Compound 1.01 taught in EP 508 126. This data clearly demonstrate unexpectedly improved results obtained by the compounds encompassed by formula I of the present invention compared to the closest prior art compounds.

WO 96/21652 fails to disclose mixtures of their inventive compounds, which as discussed above are different from the presently claimed herbicides, with co-herbicides at all. On page 32 of the '652 reference, it is taught that the compositions of the reference "can also comprise ... other active substances." No other discussion of co-herbicides is provided. The data clearly demonstrate the unexpectedly improved herbicidal properties obtained by compounds of formula I of the present invention compared to the closest compositions taught in the cited prior art. Accordingly, mixtures of compounds of formula I with a select list of co-herbicides should also be considered unexpected and non-obvious. The unexpected benefits obtained by mixing herbicides of formula I and the select list of co-herbicides of the present invention are demonstrated in the Examples on pages 39-44 of the present application.

In Summary:

Mühlebach et al. is not available as a reference since it had not yet been published when the present application was filed.

Tobler et al. teach that certain herbicides, among them compounds which are similar to (but not the same as) the inventively used ones with regard to chemical structure, can be safened by the compounds of the formula I. Note that the pyrazoline compounds according to Tobler et al do not contain the inventively used CH₂CH₂-O-CH₂CH₂ group formed by substituents A2 and B2 (see page 37 of this reference; the Examiner in this respect refers to an alkyoyalkyl group which, as a monovalent substituent, is, of course, **different** from said bivalent CH₂CH₂-O-CH₂CH₂ group formed by R4 and R5 together). Further, the safeners disclosed in this reference are different from the inventively used ones.

Although Applicants do not consider Muhlebach et al. as an available reference, the combined teachings of Mühlebach et al. and Tober et al. fail to render obvious the claimed compositions. Instant claim1 refers to a combination of the herbicides of the formula I with certain co-herbicides. The combined teachings of the references are silent of such combinations as the referential combined teaching compulsorily requires the presence of the safeners of the formula I. Further, the safeners used in Tobler et al are different from the inventively used ones. In view of the explanations given on page 1 of the present specification which reflect the general understanding in the art of the use of safeners, one cannot conclude that these safeners of the

formula I, which work in combination with the herbicides described in Tobler et al, can successfully be used in combination with the inventively used herbicides. Thus, the finding of safeners for the instantly used herbicides is unobvious over the teachings of the cited art.

In view of the above amendments and arguments, Applicants respectfully submit that the rejection under 35 U.S.C. §103(a) has been overcome and hereby request that this application be passed to issue.

As this response is submitted within three months from the mailing date of the Office Action, no additional fees are believed necessary.

However, in the event the undersigned is mistaken in his calculations, an appropriate extension of time to respond is respectfully requested, and the Commissioner is authorised to debit the appropriate fee for that extension, or any other fee, from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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